

No. 231

UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT

OCTOBER TERM, 1894

JOHN HAMMOND,
Plaintiff in Error

v.s.

STOCKTON COMBINED HARVESTER AND
AGRICULTURAL WORKS,
Defendant in Error

BRIEF FOR DEFENDANT IN ERROR

JNO. L. BOONE,
Att'y for Defl. in Error

HANDCOCK BROS. PR. 681 MARKET

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Facts of the Case

This was a suit at law for the infringement of a design patent. The patent was entitled "Design for a Railroad Car Body." The patent was issued September 15th, 1891, and is numbered 21,042. The design (?) which the patent purports to cover is what is known as a double ended car; that is, it is the well known car now in use all over the country on street railroads, —cable and electric—wherein a central closed compartment, having an open compartment at each end, is constructed on a single floor and mounted on two four-wheeled swivel trucks— one truck at either end of the car.

The case was first tried before a jury December 20th, 1893, and the jury found in favor of the plaintiff, and assessed the damages at \$250, the statutory penalty. Defendants made a motion for a New Trial on several grounds specified in the notice on page 18, Record, and after a hearing of the motion the Court set aside the verdict and granted a new trial. The case came on again for trial on the 20th day of March, 1895, and a jury being waived, the case was tried by the Court, and judgment in favor of defendant was made and rendered. This appeal is from that judgment.

It was admitted on the trial, by the defendant, that it had constructed and sold, since the date of said patent, one or more car bodies, consisting of a rectangular central closed compartment, having symmetrically arranged skeleton or open work rectangular sections at each end, within which there were seats lying lengthwise and crosswise of the car, while at each end of the car floor is a vertical dasher, the whole being surmounted by a horizontal roof-surface, and that said car body was mounted on swivel trucks at either end.

It was admitted, on the part of plaintiff, that prior to the alleged invention of plaintiff, cars had been used on Market street in San Fran-

cisco in which the car bodies consisted of a rectangular closed compartment, having at one end a symmetrically arranged skeleton or open work rectangular section, within which were seats lying lengthwise and crosswise of the car, while at each end of the car floor was a vertical dasher, the whole being surmounted by a horizontal roof surface, and that said car body was mounted on swivel trucks at either end.

It was also admitted by plaintiff, that long prior the plaintiff's alleged invention, car bodies had been constructed with a central rectangular closed compartment, having platforms at either end, a vertical dasher at each end of the car floor, the whole surmounted by a horizontal roof surface, and that long prior to plaintiff's alleged invention seats had been arranged in a car lengthwise and crosswise of the car.

It was also admitted by plaintiff, that long prior to plaintiff's alleged invention, a car body consisting of a rectangular central closed compartment, with platform and vertical dasher at each end, had been connected with a dummy car, said dummy car consisting of a symmetrically arranged open compartment, with seats arranged lengthwise and crosswise of the car, with a vertical dasher at each end of the car floor; passageways leading from the street to

the space inside the dummy and a horizontal roof surface surmounting the whole.

From these admissions it appeared that all plaintiff had done, was to substitute for the platform which had previously been used on the rear end of the anterior Market street cars, an open compartment *precisely similar to the open compartment which was in use at the front end of those cars* in other words, he constructed both ends of the car just like one end of the Market street car was, before his alleged invention.

No claim was made that the alleged patentee invented any new mechanical device, or made any alteration or change in the construction of the added open compartment, or that any adaptation or change whatever was made, except that he made a passageway leading from the car door alongside the end of the open compartment to the street.

After a full hearing the Court held that the patent was void for want of invention and rendered its judgment in favoring the defendant.

Argument

The design (?) patent sued on is an anomaly. How it ever passed the scrutiny of the Patent Office is one of the enigmas that can only be explained by the party who engineered it through that office. In a thirty years exper-

ience of close intimacy with patents, and the Patent Office, this counsel has never met with a similar case. The law authorizing the issue of patents for designs, we submit, was never intended to cover *mechanical* structures and machines such as car-bodies. If it was, we see no use for any inventor to take out a mechanical patent on his machine or structure, and pay more than twice the amount of fees that he would have to pay for a design patent. What is the use of any other patent law if a design patent can be issued to cover such devices and structures?

The law of design patents was intended to protect new forms and shapes; things ornamental and pleasing to the eye, and relates particularly to pictures; the outlines of statues, busts, and matters of ornament *and not to shapes in general*. If it includes the latter, every new invention and improvement has a new shape *per force*, consequently every newly invented or improved thing, be it a machine or any thing else, might be the subject of a design patent. Every newly invented or improved ore mill, threshing machine, hoe, chair, or other mechanical device or structure *has some new shape*. The mere fact that it is new, or improved, *necessitates* some difference in shape and appear-

ance. The patent law requires an inventor to pay government fees amounting to thirty-five dollars for every patent for a mechanical invention for which there is only one term of seventeen years. but the inventor of a new design can take out a three and a half years patent for ten dollars, for seven years for fifteen dollars or for fourteen years for thirty dollars. If the inventor of an improved ore mill, threshing machine, hoe, chair or other mechanical device can obtain a design patent on the shape, configuration or outline of his machine or device, why should he apply for a mechanical patent? What use would one be to him? The outline shape, configuration of his device *is the device itself*, because in order to infringe upon his patent the outline or configuration must be copied, or to state it reversely, if another person should build or construct his improved machine or device, or an imitation of it, such person would have to copy substantially its outline, shape and form.

Take for instance the well known article a garden hoe, an inventor devises and invents an improvement in the hoe. This improvement gives a new, or added new shape and outline. Why? Because it is different from the old hoe.

Otherwise his improvement would be intangible or rather *unseeable*. Now if he can patent the new shape, figure and outline, by obtaining a design patent, what is the use of a mechanical patent? It will cost him more than a design patent and is more difficult to obtain, for it is a recognized fact that mechanical patents are more difficult to obtain than design patents.

We submit that the law of Design patents was never so intended. Design patents are limited to pictures and ornaments, the outline of works of art, configuration or shape of manufactured articles such as paper weights, picture frames, jewel posts, mantels and such other articles where beautiful shapes are important.

Design patents are admittedly a low order of patents. Many Judges and even the counsel for plaintiff in error in this brief have likened them to trade marks.

The patent here in controversy purports to be for a design *for a car body*. An inspection of the patent shows that it covers the entire car—body, soul and breeches. It includes the central compartment, the end compartments, the seats, the dashers, the roof and the trucks. If the patent had claimed some novel shape for a car body, such for instance as an octagonal body or a triangular body, we could then see

some consistency in protecting it with a design patent, but it does nothing of the kind. It actually covers *a mechanical structure*, and the soul of the claim is the *mechanical construction*, a field that can only be covered by a mechanical patent. We again repeat that the patent is an anomaly. It is the only one of the kind.

Must be an Invention?

In *Cahoone Barnett M'fg Co. vs. Rubber and Celluloid Harness Co.*, 45 Fed. Rep. 582, Judge Green (C. C. Dist. N. J.) said: "*I think it may be taken as settled* that to sustain a design patent, "there must be exhibited in the production of "the design an exercise of the inventive faculty, "as clear and of as high a degree as is called "for in patents for inventions and discoveries. "In both, the final production must have been "engendered by the exercise of brain power, "and to such an extent that it may be said to "be born of genius."

In *Western Electric Co. vs. Odell*, 18 Fed. Rep. 321, Judge Blodgett quoted approvingly from Simonds on design patents, 212, as follows:

"For a time it was the practice of the Patent "Office to grant these design patents for almost "any subject matter presented, and with little "or no inquiry as to whether any degree of "patentable origination had been exercised.

“It is now tolerably well settled that design patents
 “stand on as high a plane as utility patents,
 “and require as high a degree of exercise of the
 “inventive or originative faculty. In patent-
 “able designs a person cannot be permitted to
 “select an existing form and simply put it to a
 “new use, any more than he can be permitted
 “to take a patent for a mere double use of a
 “machine, but the selection and adaptation of
 “an existing form may amount to patentable
 “design, as the adaptation of an existing
 “mechanical device may amount to patentable
 “invention.

In *Northrop vs. Adams*, 2 Ban. and Ard. 597,
 it was held that novelty is required in designs
 as in other inventions, and the same doctrine
 was held in *New York Belting and Packing Co.*
vs. New Jersey Car Spring and Rubber Co., 30
 Fed. Rep. 785, *Wooster vs. Crane*, 5 Blatch, 282.

Mr. Justice MacArthur in delivering the
 opinion of the Supreme Court of the District of
 Columbia in the case of *F. G. & W. F. Neider-*
inghaus reported in 8 Official Gazette, 279, said:

“The thing provided for in the law is in ex-
 “press language ‘any new and original design
 “for a manufacture’—‘any new and original de-
 “sign for printing’—‘any new, useful and origi-
 “nal shape, ‘the same not having been used by

“others before his invention or production there-
 “of, the use of an old design upon an old ob-
 “ject is clearly excluded by the statute, and
 “mere changes or ‘double use’ cannot receive its
 “protection.

“*Besides it is well understood that the same de-
 “gree of originality is required in both design and
 “functional patents. That is, the claim must not
 “be for a copy or imitation, of what is already in
 “existence.*

With what uniformity, all these courts have agreed that *it is now well settled* that patents for designs require invention in the same degree that a mechanical invention does.

“*Does the car body of the patent display in-
 vention?*

It is admitted that cars of the same identical construction, having an open compartment with seats, etc., at one end, and an ordinary car platform on the opposite end, instead of having an open compartment at each end, were in use long prior to plaintiff’s alleged invention.

All plaintiff did then was to remove the ordinary car platform, and substitute for it an open compartment, *precisely like* the open compartment that was already in use at the opposite end of the car.

Did this require invention? No change was made, no alteration or adaptation. He simply duplicated the pieces and parts of the old open compartment; put them together in the same way they were put together before, and connected them with the car in precisely the same way, and by the same means they had been put together and connected with a car long before.

Walker on Patents at Sec. 34, pg. 32, says: "§34 It is not invention to duplicate one or more of the parts of the machine," and he cites the case of *Dunbar vs. Meyers*, 94 U. S. 197, where the Supreme Court of the United States decided that it was not invention to put a plate on both sides of a circular saw to spread the sawed stuff, when a plate had been before used on one side only, for that purpose, and also to *Millner vs. Voss*, 4 Hughes, 262, where the patentee put two fire places on each side of a furnace, where only one had been used on one side before. Both patents were held to be void for want of invention.

We also cite *Stevenson vs. Brooklyn Cross-town Railroad*, 14 Fed. Rep., 461, which was afterwards affirmed by the Supreme Court of the United States in 114 U. S. 156. In this case the patent was for duplicating the pull straps

for ringing the bell in a street car. Formerly only a single pull strap was used, and it passed through the middle of the car under the ceiling or roof, Stevenson duplicated them and put one on each side of the car. The Courts declared the patent void for want of invention.

See also *Tack Co. vs. Two Rivers Man'g Co.*, 109 U. S. 119

So much for *Duplication* which simply means making two things, where one thing of the same kind existed before.

But there is another doctrine of patent law known as the doctrine of *Double Use*. It includes simple duplication, but extends further, and embraces that extensive field of mechanical interchange where a thing well known for one purpose, is attempted to be patented for another purpose.

Walker on Patents on page 36, lays down the rule in Section 38, as follows: "It is not invention to use an old thing or process for a new purpose."

Numerous citations are given in the foot notes under this section and we need not occupy space here to repeat them.

We also cite *Robinson on Patents*, Vol. 1 on page 358, in the foot notes near the bottom of

the page in the first column, under the heading "The Use a Double Use" and the long list of authorities there cited.

See also *Brinkehoff, et al., vs. Aloe* 146, U. S., 515.

In *Yale Lock Manuf'g Co. vs. Berkshire National Bank*, 17 Fed. Rep., the patent was for two time movements in a Safe Lock to control the lever which in turn controlled the dog instead of one time movement as theretofore used, after stating the facts Judge Lowell said as follows:

"In this State of the Art there was no patentable novelty in putting one old form of lock, a time lock, in place of another, a combination lock, in the instance above mentioned of two combination locks dogging one compound bolt-work. Nor was it patentable to substitute a well known multiple bolt-work for two such bolt-works with which a time lock and combination lock had been combined in another of those instances. But my opinion does not depend wholly upon the proved state of the art, excepting that multiple bolt work was a familiar part of a vault door. There never was a time in my judgment since the first lock was invented by Jubal Cain, or whoever was

“the inventor, when there was patentable
 “novelty in combining two locks with a single
 “door. There may be no record of its having
 “been done but no one can doubt that whenever
 “one lock was found to be inadequate, an-
 “other was added. I cannot make this plainer
 “by argument, but I may perhaps by illustra-
 “tion. When nails were invented and had be-
 “come public property, the carpenter who had
 “the right to use one nail might use two, if
 “he found one would not fasten his two pieces
 “of wood sufficiently for his purpose. If one
 “has invented a pair of shoes of a new form,
 “and another pair of shoes of a different form, a
 “combination consisting of putting a shoe of
 “one of these forms upon the right foot, and
 “one of the other form upon the left would not
 “be patentable. If one has made a new plow
 “and used it with oxen, it is not patentable to
 “use the same plow in combination with a horse,
 “independently of the mechanical adaptation.
 “In the language of the law it is a double use.
 “To the man who invents a lock there most
 “always remain the right to use it on an old
 “door, in addition to any old lock which he
 “finds or may choose to put on that door.

Now coming down to design patents we cite
 the case of *Paine vs. Snowden*, 50 Fed. Rep., 776,

decided by the Circuit Court of Appeals for the Third Circuit. This was a design patent for a chair.

The first claim of the patent was as follows:

“Claim (1) The improved design for common
 “round bow back chairs, consisting in the upper
 “part of the bow and rounds provided with a
 “sheet of suitable material, as wood, bent to con-
 “form to the curvature of said bow-back and
 “rounds, leaving the rounds between said sheet
 “and seat exposed substantially as and for the
 “purpose specified.”

The Court said :

“It appears that prior to 1882, Gardner &
 “Co., manufactured and sold in the city of New
 “York, veneers, chairs and settees. Their
 “illustrative catalogue, issued and distributed
 “in June, 1882, is an exhibit in the case, and it
 “is shown that the cuts therein contained are
 “true representations of the chairs which they
 “manufactured and sold long before the date of
 “Paine’s alleged invention. Those chairs were of
 “different forms, styles and sizes. The variety
 “was great. Some of the chairs had curved
 “backs to conform to the shape of the human
 “body. The chairs were provided with per-
 “forated veneer seats. They also had pieces of
 “perforated veneer of various shapes and of

"ornamental appearance fastened by nails to
 "the backs of the chairs, and in the instances
 "where the backs were curved, the back pieces
 "of veneer were fitted so as to conform to the
 "curvature. Sometimes the veneer back was
 "continuous with the seat, an unbroken piece
 "of perforated veneer being used for the pur-
 "pose. In other instances the perforated
 "veneer back piece and the seat piece were
 "separate.

"Now, it is true, that among the Gardner
 "illustrations *we do not find* the common bow-
 "back chair: but everything else disclosed by
 "Paine's patent is there to be seen. However
 "the bow-backed chair—that is a chair having
 "a continuous piece bent to form the sides and
 "top of the back, both ends being fastened
 "in the seat—was old. Did it then in view of
 "what had already been done, require inven-
 "tive genius of any order to apply to the curved
 "back of such a chair a piece of perforated
 "veneer or other flexible material? The Court
 "below ruled that it did not, and in that judg-
 "ment we entirely concur."

In *Western Electric Mfg. Co., vs. Odell*, 18 Fed.
 Rep., 321, the patent was for a design for the
 face or dial of an annunciator. Judge Blodgett
 said:

“In *Gorham vs. White*, 14 Wall, 511, the Supreme Court said: ‘In whatever way produced it is the new thing produced which the patent law regards.’ I have read enough to show that the text of Mr. Simonds is fully sustained by the authorities quoted.

“The patent in this case is for a mere black dial-plate upon which the inventor places a gold letter or figure indicating the number of the room, and a white metal pointer. There is no border or configuration upon the dial, or around it, of a peculiar or ornamental character, nor is there a cornice or binding of any kind, but simply a bold black face with the gold-colored figures or letters and the silver or light metal hands or indexes; nothing new or original in the shape or ornamentation of the dial-plate, figures, or pointers is shown or indicated. The only trouble I have had with the case has been whether the Court could import sufficient of what we call common knowledge into the case to say, on demurer, that this was an old device applied to a new use. While the case was on argument I drew my watch from my pocket, as I thought the analogy was a fair one, and opening it I found substantially the combination on its face or dial with merely a change of the colors that is shown on this

“patented dial-plate; that is, I found a white
“face instead of a black one, and black figures
“indicating the hours, and metal or gold colored
“hands, so that there was the same contrast of
“colors as that on which this inventor claims
“to base his patent. There were the three
“elements, the white face, the black figures, and
“the gold colored pointers making the precise
“combination for the purpose of contrast which
“the inventor says is the gist of his invention.
“An examination of the decision of the Supreme
“Court of the United States in *Brown vs. Piper*,
“91, U. S. 37, satisfies me that the Court can,
“from its common knowledge, say that the de-
“sign covered by this patent is only a new use
“of an old and well known device. Certainly
“there is nothing more completely within the
“scope of common knowledge than the dial-plate
“of a watch. The clock before us in this room
“presents nearly the contrast the inventor
“claims for his device, and you can hardly walk
“the streets without finding in nearly every
“sign-board the same contrast of colors for the
“purpose of making an ornamental and attrac-
“tive sign. As I have already suggested, if in
“connection with this contrast of colors there
“had been a border around the dial of a new
“and original composition in combination with

“these old parts, with the old contrast of colors, “the patent might be sustained, but there is no “such combination here, and the bill was dismissed.”

The Court here proceeded on proper lines. It found that the devices included in the claim were old, and it proceeded to seek some foundation for a design. If there had been an ornamental border or anything that could be included in a design, the patent would have been sustained as being *for that ornamentation*. Apply this rule to the present case. The mechanical features are all old, consequently the patent cannot be for them. The patent is for a design. The mechanical structure was old and does not constitute a design. If the car body had any ornamentation, bead work, molding, outline, figure by painting or otherwise, then we might figure out a design to sustain the patent on. But all designs are wanting. It is merely an attempt to cover a mechanical structure, old in every part by a design patent.

But the case of *Smith vs. Whitman Saddle Co.*, 148 U. S. 675, settles the question of invention and patentability in this class of case. Mr Justice Fuller in delivering the opinion of the Court, said:

"The evidence established that there were
 "several hundred styles of saddles or saddle-
 "trees belonging to the prior art, and that it
 "was customary for saddlers to vary the shape
 "and appearance of saddle-trees in numerous
 "ways according to the taste and fancy of the
 "purchaser, and there was evidence tending
 "to show that the Granger tree was sometimes
 "made up with an open slot, and sometimes
 "without, and sometimes with the slot covered
 "and padded at the top, and sometimes covered
 "with plain leather, while it clearly appeared
 "that the Jennifer Cantle was used upon a
 "variety of saddles, as was the open slot.
 "*Nothing more was done in this instance (except*
 "*as hereafter noted) than to put the two halves of*
 "*their saddles together in the exercise of the ordin-*
 "*ary skill of workmen of the trade and in the way*
 "*and manner ordinarily done. The presence or*
 "the absence of the central open slot was not
 "material, *and we do not think that the addition of*
 "*a known cantle to a known saddle, in view of*
 "*the fact that such use of the cantle was common*
 "*in itself, involved genius or invention or produced*
 "*a patentable design.*"

Now let us parallel the case at bar with the
 case just cited. Cars are and have been for
 years made in various styles. It was custom-

ary for car builders to vary the shape and appearance according to the demands of purchasers. Open compartments were old, closed compartments with one open compartment at one end were old. Seperate open dummies attached to closed cars were old. All that the plaintiff here did was to put an old open compartment which had previously been used on one end of a closed car, on the other end. Any ordinary workman could have done it just as well as the plaintiff. A mere school boy could have taken a picture of the old Market Street car with its open compartment at one end, laid it down on a table, traced the open compartment with a pencil on a sheet of paper, then by laying his tracing at the opposite end of the same car he could have transfered the picture to that other end and we would have the design. Mr. Hammond might have said to one of his workmen, "Take off that rear platform from one end of the prior Market St. cars, and build an open compartment in its place just like the open compartment you see on the other end," and the workman, without further instructions could have produced the patented(?) design and car. Is this invention? It certainly would require no more genius or inventive skill than would be necessary for a

carpenter or house builder to construct a back porch on a house just like a front porch on the same house. The Court will take judicial notice, as Judge Blodgett did in *Western Electric Mfg. Co., vs. Odell, supra*, when he compared his watch face to the dial of the annunciator, that there is hardly a passenger or ferry boat that floats that does not have a rectangular central closed compartment (cabin) with open compartments at either end with seats arranged lengthwise and crosswise with dashers (bulwarks) at each end, the whole surmounted by a horizontal roof surface. All they need is the trucks to complete the design. The Courts have decided over and over again that this is not invention. The Judge of the lower Court who tried this case gave it special study and attention. He wanted to sustain the patent if he could. But he could not find "*that small modium*" of invention referred to by plaintiff's counsel in his brief, that the law says is necessary to sustain a design patent.

We therefore respectfully submit that the judgment of the lower Court should be affirmed.

Respectfully submitted,

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